

REMARKS/ARGUMENTS

These Remarks and amendments are responsive to the Office Action mailed November 18, 2004 (the "Office Action"). The Applicants respectfully request reconsideration of the claim rejections for at least the reasons set forth below.

STATUS OF THE CLAIMS

Claims 1-41 are pending in the application.

Claims 1 and 18 have been rewritten to include, among other things, certain limitations originally presented in claim 5. Claim 34 has been rewritten to include, among other things, certain limitations originally presented in claim 15.

Various other amendments to the claims have been made to provide more consistent claim language and correct typographical and/or grammatical errors, and are not made in response to prior art or any failure to satisfy the conditions of patentability.

Claims 5, 38, 40 and 41 have been cancelled.

AMENDMENTS TO THE SPECIFICATION

Various typographical errors have been corrected in the specification. No new matter is believed to be added by these amendments.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102(e)

The Examiner rejected claims 1-5, 8-10, 12-23 and 26-41 under 35 U.S.C. § 102(e) as allegedly being anticipated by Hollingsworth (U.S. Pat. No. 6,157,808). As explained below, the Applicants respectfully traverse and request reconsideration of the rejection.

Anticipation under 35 U.S.C. § 102(e) occurs when "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); *see also* M.P.E.P. § 2131. Applicants respectfully submit that Hollingsworth does not anticipate the claims of the present invention because it does not disclose or

reasonably suggest the appointments information features of independent claims 1, 18 and 37, or the communication interface features of independent claims 34 and 39 (as well as dependent claim 15).

Claims 1, 18 and 37

Claims 1 and 18 have been amended to include features relating to appointments information similar to original claim 5.¹ More specifically, amended claim 1 recites the feature of an "appointments database adapted to contain a source of appointments information, said appointments information including at least information related to one or more products offered by one or more suppliers," and further recites that the "licensee information" includes "information related to whether said licensee is appointed to sell at least one of said one or more products offered by said one or more suppliers." Amended claim 18 recites that the method includes the step of "obtaining appointments information from one or more suppliers, said appointments information being related to one or more products offered by said one or more suppliers," and "determining an extent to which said at least one entity is appointed to sell at least one of said one or more products offered by said one or more suppliers." Independent claim 37, which was presented in a previous amendment (and amended in other regards in this amendment), also includes this appointments information feature in the recitation: "wherein said licensee information further includes information related to licensee appointments by a supplier of a product that may be sold by said at least one licensee." Hollingsworth does not disclose or reasonably suggest these elements, and therefore Applicants respectfully submit that Hollingsworth does not anticipate independent claims 1, 18 or 37.

¹ It will be understood that the term "appointments" refers, in the context of this application and the art to which it applies, to products that an insurance agent is "appointed" (i.e., authorized or approved) to sell, rather than to time appointments (such as "appointments" to meet with a doctor). See, e.g., Specification p. 10, ll. 11-19.

Moreover, as noted above, the "appointment information" features of claims 1, 18 and 37 are similar to original claim 5 of the application. The Examiner rejected original claim 5 under 35 U.S.C. § 102 in the non-final Office Action dated February 12, 2004, but did not appear to provide a specific basis for the rejection. In the final Office Action mailed November 18, 2004, the Examiner again rejected claim 5. In support of the rejection of claim 5, the Examiner stated:

As per claims 1-5, the type of information is determined to be non-function descriptive data and is given little patentable weight. Furthermore, the fact that the databases contain licensee agency information is considered to be non-functional descriptive data and is also given little patentable weight. The database in Hollingsworth and the processors are capable of performing the same function as the system in the applicant's invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into Hollingsworth the data of this invention since such data does not functionally relate [sic] to the structure and the subjective interpretation of the queries does not patentably distinguish the claimed invention.

Office Action, p. 4, ll. 4-12. The Examiner also rejected claim 37 in the final Office Action, but did not provide any specific basis therefor, so the Applicants assume that the reasoning set forth with respect to claim 5 was intended to apply to claim 37 as well.

The Applicants respectfully disagree with the Examiner's characterization of Hollingsworth and the present invention. To begin with, the Examiner argues that "[t]he database in Hollingsworth and the processors are capable of performing the same function as the system in the applicant's invention." However, Hollingsworth fails to describe *any* capability (*i.e.*, database and processor structures and organization) to store information relating to products offered by suppliers and determine whether a licensee is authorized (appointed) to sell such products, as required in claims 1, 18 and 37. Indeed, if a person were to build and operate the system described in Hollingsworth, that person clearly would *not* be able to enter data about products for sale by suppliers into the system, and the system would *not* be able to inform an

operator as to whether a licensee is authorized to sell such products. Hollingsworth simply does not describe these capabilities of claim 1, 18 and 37, and therefore such a system literally can not be used to perform the same function of the claimed invention, as alleged by examiner.

The Examiner also argues that "the type of information is determined to be non-functional descriptive data and is given little patentable weight," and states that "claims directed to an apparatus/system must be distinguished from the prior art in terms of structure rather than function alone." Again, the Applicants respectfully disagree. The system and method described in amended claims 1, 18 and 37 all require the capability to store information related to products offered by supplier. These claims also require the information relating to a licensee capable of holding a license to *further* relate to whether the licensee can sell the products offered by the supplier. These elements necessarily require a database structure that is formatted to receive the described data, and Hollingsworth does not describe receiving data in this format — as such, the database structure (*i.e.*, the data formatting) is different. Furthermore, the claims require the additional ability to correlate the licensee information to both licensing requirements *and* product appointments, which goes beyond the processor capabilities described in Hollingsworth, thus providing a structural difference in the processor structure (*i.e.*, the processor routines and commands).

Despite these differences, the Examiner also argues that "it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into Hollingsworth the data of this invention since such data [is] not functionally related to the structure and the subjective interpretation of the queries does not patentably distinguish the claimed invention." By invoking the "obvious to one of ordinary skill in the art" language in this § 102(e) anticipation rejection, the Examiner appears to be asserting that Hollingsworth inherently includes the structure and method steps of the present invention. However, a missing element is not inherently disclosed unless it necessarily flows from the disclosure, and it is not sufficient to prove inherency if a

certain thing *may* result from a set of circumsances. *See, In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999); and M.P.E.P. § 2112. In the present case, the fact remains that a person simply could *not* sit down in front of a device constructed according to the Hollingsworth invention and enter data relating to one or more products offered by one or more suppliers, and could *not* enter data relating to (or determine) whether a licensee is appointed to sell such products, as required by claims 1, 18 and 37. As explained above, such additional features and functions are simply not provided by Hollingsworth unless one were to substantially modify the Hollingsworth device in a non-obvious manner.

In view of the foregoing differences, it can not be said that the database and processor structures and method steps of the present invention "necessarily flow" from the disclosure of Hollingsworth, and therefore *no* inherent disclosure of the claimed invention exists. *See M.P.E.P. § 2112*. Furthermore, the features of claims 1, 18 and 37 of having appointments information relating to products offered by suppliers and additional information relating to whether a licensee is appointed to sell such products is not an obvious modification or distinction over the Hollingsworth reference. Hollingsworth describes a system that deals solely with identifying whether employees meet training requirements. In contrast, claims 1, 18 and 37 identify whether agents meet licensing requirements and *also* identify the products offered by suppliers of goods *and* whether the agents are approved (*i.e.*, appointed) to sell such goods. Clearly this goes well beyond the disclosure of Hollingsworth and any obvious variations thereof, because Hollingsworth fails to teach or reasonably suggest any processor or step analogous to associating product information with suppliers or agents authorized to sell such products.

Furthermore, the Applicants note that the mere fact that a structure can be modified to be asserted against the present invention (and the Applicants do not have any reason, at this time, to believe that Hollingsworth can be modified to provide the present invention) does not render the modification obvious *unless the prior art also*

suggests the desirability of the modification or combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); see also, M.P.E.P. § 2143.01. In the present case, the Examiner has not identified any desirability for this modification found in the prior art, and appears to have developed the desirability solely from the teachings of the present application, which is an improper basis for establishing obviousness. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). In view of the lack of any motivation to modify Hollingsworth to obtain the invention of claims 1, 18 and 37, the Examiner's § 102/103 inherency rejection is respectfully submitted as being improper.

In summary, Hollingsworth does not teach or disclose, literally or inherently, a database structure adapted to contain appointments information related to products offered by a supplier, or a licensee database containing information related to a licensee appointed to sell products offered by a supplier, or steps involving the use or manipulation of such information, as recited in claims 1, 18 and 37 of the present application. The prior art also fails to provide the requisite motivation to modify Hollingsworth to have this structure, and therefore the differences between the prior art and the claimed invention are not obvious. Thus, Hollingsworth does not anticipate claims 1, 18 and 37, and reconsideration and allowance of these claims are respectfully requested.

Claims 15, 34 and 39

Turning now to dependent claim 15 and amended independent claims 34 and 39, the Applicants again respectfully traverse the rejection. Claim 15 recites a "communication interface capable of accessing at least one of said licensing authorities, said at least one licensing authority being a state entity responsible for administering licensing information; and said processor is connectable to said interface thereby permitting information to be exchanged between said licensing information system and said at least one state entity." Similarly, claim 34 recites "obtaining licensing requirements information from a plurality of licensing authorities by way of at least one processor capable of accessing at least one of said plurality of licensing authorities

through a communication interface," and claim 39 recites "a communication interface capable of accessing at least one state entity responsible for administering licensing information, wherein said at least one processor is connectable to said interface thereby permitting information to be exchanged between said licensing information system and said at least one state entity." These features are not disclosed or reasonably suggested by Hollingsworth.

In support of the rejection of original claim 15, the Examiner cited to column 3, lines 25 to 40 and various other parts of Hollingsworth as allegedly disclosing "information from at least one state entity responsible for administering licensing requirements." While Hollingsworth generally discusses the use of licensing requirements *within* the Hollingsworth system, the patent does *not* say anything about an actual communications interface with a *state entity — an external source* — to obtain such requirements, as required by claims 15, 34 and 39. Instead, Hollingsworth is believed to simply assume that the information is somehow inputted into the system, and then, at most, describes *internal* communication of such information. As such, Hollingsworth fails to anticipate or render obvious this limitation as it appears in claims 15, 34 and 39. Claim 15 is also believed to be patentable by virtue of its dependency from claim 1, which, as demonstrated above, is allowable over Hollingsworth. For at least these reasons, reconsideration of this rejection is respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)

The Examiner further rejected claims 6, 7, 11, 24 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Hollingsworth. These claims depend from independent claims 1, 18, 34, 37 or 39, and should be patentable for at least the same reasons as the independent claims, as explained above. As such, the § 103 rejections are believed to be moot, and reconsideration thereof is respectfully requested.

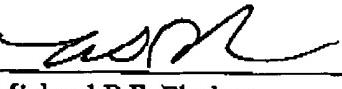
CONCLUSION

The Applicants respectfully submit that the application is in condition for allowance, and notification thereof is respectfully requested. If the Examiner believes that prosecution might be advanced by discussing the application with Applicants' counsel, in person or over the telephone, Applicants' counsel would welcome the opportunity to do so.

A Request for Continued Examination and the appropriate filing fees are submitted herewith. However, in the event the provided payment is insufficient or in excess, the Commissioner is hereby authorized to charge or credit the undersigned's Deposit Account No. 50-0206 to correct any payment error.

Respectfully submitted,

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